THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today as not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JURGEN BEIL

Appeal No. 2005-0333
Application: 09/918,074

ON BRIEF

Before PAK, WARREN, and PAWLIKOWSKI, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 18, which are all of the claims pending in the above-identified application.

APPEALED SUBJECT MATTER

The subject matter on appeal is directed to a fish bait comprising a porous thermoplastic plastic containing at least one fish luring aromatic and/or fish enticing substance and methods for making and using the same. See the specification, pages 1-3. Details of the appealed subject matter are recited in representative claims 1, 14 and 18, which are reproduced below:

1. Method for producing aromatic and/or enticing articles and parts thereof, comprising treating a material comprising porous, thermoplastic plastic with at least one fish-luring aromatic and/or enticing substance.

14. Aromatic and/or enticing articles, comprising a porous, thermoplastic plastic treated with at least one fish-luring aromatic and/or enticing substance.

18. Method of luring fish, comprising placing a porous, thermoplastic plastic treated with at least one fish-luring aromatic and/or enticing substance in a body of water containing fish.

PRIOR ART

The prior art references relied upon by the examiner are:

Larsen et al. (Larsen)	3,351,495	Nov. 7, 1967
Sibley et al. (Sibley)	4,887,376	Dec. 19, 1989
Reinhardt et al. (Reinhardt)	4,957,787	Sep. 18, 1990

REJECTION

Claims 1 through 7 and 13 through 18 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Reinhardt and Sibley. Claims 8 through 12 stand rejected under 35

U.S.C. § 103 as unpatentable over the combined disclosures of Reinhardt, Sibley and Larsen.

OPINION

As stated in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000),

> Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cri. 1998). Thus, every element of a claimed invention may often be found in the prior art. *See Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.** *See In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). (Emphasis added).

Here, as correctly argued by the appellant, the examiner has not identified any motivation, suggestion or teaching of the **desirability** of employing a fish-luring aromatic, such as the one taught in Sibley, in the artificial flower of the type discussed in Reinhardt. To employ a fish-luring aromatic as proposed by the examiner would be to render the artificial flower described in Reinhardt unsuitable for its intended purpose. *See Gordon*, 733 F.2d at 902, 221 USPQ at 1127; *Ex parte Hartman*, 186 USPQ 366, 367 (Bd. App. 1974).

As acknowledged by the examiner (Answer, page 5), Reinhardt, for example, discloses treating its artificial flower with perfume, an aromatic pleasant to humans. See also, e.g., Reinhardt, column 1, line 23. The examiner has not found that Reinhardt's artificial flower is known or intended to be used as a fish-bait article. See the Answer in its entirety.

To remedy the deficiency of Reinhardt, the examiner has relied on the teachings of Sibley. See the Answer, page 3, together with the final Office action dated December 13, 2002, page 2. As acknowledged by the examiner (the final Office action dated December 13, 2002, page 2), however, Sibley only teaches using a fish-luring aromatic in a fish-bait article. Although the examiner has asserted at page 3 of the Answer that the perfume referred to in Reinhardt is equivalent to or inclusive of a fish-luring aromatic, such as the one taught in Sibley, the examiner has not supplied any factual basis to support such an assertion. *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002)("'The factual inquiry whether to combine references must be thorough and searching.'...It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with."). Larsen relied on by the examiner,

for example, is directed to using a specific polyolefin article as a battery separator.

On this record, the examiner has not demonstrated that the prior art references relied upon would have rendered the claimed subject matter obvious to one of ordinary skill in the art within the meaning of Section 103.

OTHER ISSUE

Although Sibley is directed to using a fish attractant in a thermoset(cross-linked) plastic, it mentions in "BACKGROUND ART" known scented fish-baits comprising fibrous plastic net works and sponge-like devices containing fish attractants. See column 1, line 60 to column 2, line 24. It is not clear from Sibley that the fibrous plastic or sponge-like devices of the known scented fish-baits are made of a thermoplastic plastic or a thermoset plastic. Thus, to fully explore the state of the prior art, the examiner is advised to conduct an additional search to determine whether these known scented fish-baits are made of the claimed thermoplastic plastic.

CONCLUSION

In view of the forgoing, we reverse the examiner's decision rejecting all the claims on appeal under 35 U.S.C. § 103 and advise

the examiner to conduct a further search as indicated *supra* prior to issuance of this application.

REVERSED

CHUNG K. PAK)
Administrative Patent Judge)
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CHARLES F. WARREN) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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